

REMARKS

Applicants have carefully reviewed the final Office Action mailed February 22, 2007. Claims 1, 3-6, 8-11 and 24-32 were pending. All but claims 1-11 have been cancelled to facilitate prosecution. Dependent claims 33 through 35 have been added. Independent claim 1 has been amended. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers. Applicants respectfully request reconsideration of the present application in view of the following remarks.

I. Information Disclosure Statement

Applicants respectfully do not understand the issue with reference CA. Reference CA is the international search report for the corresponding international application claiming priority to the present application. Another copy of the Notification of transmittal of the International Search Report or the Declaration with a mailing date of September 1, 2004, is attached. Hopefully, this addresses any remaining concerns that the Examiner has.

II. Rejection of Claims 1, 3-5, 8-11 and 24-27 Under 35 U.S.C. 102 – Japanese Reference 10-292624

Claims 1, 3-5, 8-11 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese reference 10-292624 (JP '624). Applicants respectfully traverse the rejection with respect to claims 1-11.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor*

Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990); also see MPEP § 2131.

A. “molded in one-piece from a non-metallic non-wooden material”

JP ‘624 explicitly teaches away from a one-piece non-metallic material. This is even true through its requirement that the pattern layer (4) and the reinforcing layer be laminated at will. [0017]. The very paragraph cited by the Examiner in the last office action, [0029] expressly teaches away from the claimed invention when it states: “The pattern layer and the pattern reinforcing layer as well as the peripheral rib layer and grid rib layer are formed by laminating and reinforcing the entire pattern with composite resin and laminating material, such as fibercloth, fiber mesh, resin mesh, etc.” [0019]. Such a structure may be “monolithic”, but it is not “one-piece” using the nomenclature shown in the present application.

Significantly, moreover, the form is not limited to the pattern layer (4) and reinforcing layer (5), but also requires the plate for the peripheral rib core (101), upon which the Examiner must also rely to suggest that there is a reinforcement matrix. In the claims of the present application, the reinforcement matrix is part of the “one-piece” “non-metallic non-wooden material”. In JP’ 624, it is distinct. As cited expressly in paragraph [0015]:

At the same time, rib core plates (101) for forming the peripheral ribs having nearly the same shape as the male embossed surface and made of plywood plates, corrugated boards, foam boards, steel sheets, aluminum sheets, resin plates, honeycomb plates, etc., are set at any desired gradient. . . .

Thus, the rib core plates (101) are distinct from the rest of the form, and are made from distinct plates, which can be plywood plates, corrugated boards, steel sheets, aluminum sheets, and the like. As a result, it is clear that the form of JP ‘624 is not one material even independently of the combined materials required to undertake the lamination process of both the pattern layer and the

reinforcing layer. Separate plates of material, which include metallic material and wood, are required to form rib core plates (101).

Second, despite the Examiner's attempt to ignore the required presence of the various metallic or wooden components such as rib core plates (101) as well as metallic holder 8 and collar 10, the fact is that the portion of JP '624 upon which the Examiner relies will not function independently of these metallic components. The rib core plates (101) are essential as is the ability to attach the form to metallic reinforcing plate (7) as shown in Figure 9 by way of metallic holder (8) metallic collar (10). As shown in Figure 5 of '624 and discussed in paragraph [0017], both metallic holder 8 and metallic collar are critical constituents of the structure. In fact, collar (10) is "welded integrally at arbitrary positions on the outer periphery of female threaded portions (not shown in the figure) and holder (8)." As stated in paragraph [0007]: "With the mold form for three-dimensional decorative concrete provided by the present invention, it is possible to form an embossed pattern with three-dimensional curves and having holders for holding the side pressure of concrete embedded in it, with increased efficiency of the decorative mold form assembly operation, and in the mold release operation." (Emphasis added). Thus, it can hardly be said that the form of JP '624 is formed from a one-piece non-metallic or non-wooden material.

Third, even if it were accepted that the various materials laminated together could be considered "one-piece" and it could somehow be argued that there is no teaching of either metallic or wooden components such as the rib core plates (101) or the metallic holder (8) or the metallic collar (10), it is significant that the claims further require that the entire structure be "molded in one piece from a non-metallic, non-wooden material." (Emphasis added). The requirement of lamination using distinct components to form the pattern layer (4) and pattern reinforcing layer (5) is not molding. The insertion of metallic holder (8) and collar (10) and then maintaining them in place utilizing a resin concrete or a chopped fiber blended mortar or the like is not molding. (Paragraph [0017]). Nor are the additions of separate rib core plates (101) molding, let alone being molded in one piece from a non-metallic, non-wooden material. Thus, claims 1-11 are patentably distinct from JP '624 even before amendment.

B. Outer peripheral wall with apertures

Independently of the comments made above, to facilitate prosecution independent claim 1 has been amended to recite the presence of an outer peripheral wall, the wall including a plurality of apertures, each aperture selectively receiving an attachment mechanism such that a plurality of forms may be placed in alignment by way of said apertures. No such teaching is shown in JP '624. On the contrary, JP '624 expressly teaches away from such an arrangement through its teaching of reinforcing plate (7), separator (14), holder (8) and collar (10).

Support for the amendment may be found throughout the application, including, but not limited to paragraphs [0032] through [0034].

III. Rejection of claim 4 under 35 U.S.C. § 103(a)

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over either of Japanese reference 10-292624 (JP '624) in view of European reference 623,434 (EP '434).

Obviousness cannot be established by combining prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie case* of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

related to weight, expansion, shrinkage, cracks and adherence as well as assembly when using monolithic plastic forms. See e.g., paragraphs [0003] and [0004] of the translation.

“The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 USPQ2d, at 1458 (Fed. Cir. 1998)

In re Fritch provides that “the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art,” and that “the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit concluded that “under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (Emphasis in original).

It is also respectfully submitted that the examiner has not provided adequate motivation for the combination of the references, as noted above.

IV. New dependent claims 33 through 35

Claims 33 through 35 have been added to the application. It is respectfully submitted that the claims further distinguish the claimed invention from the prior art of record. Support for the new claims can be found, for example, at paragraph [0048].

CONCLUSION

All rejections have been addressed. In view of the above amendment, applicant believes the pending application is in condition for allowance.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j).

A patent claim is obvious, and thus invalid, when the differences between the claimed invention and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103; *see also Graham v. John Deere Co.*, 383 U.S. 1, 14, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). While obviousness is ultimately a legal determination, it is based on several underlying issues of fact, namely: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. *See Graham*, 383 U.S. at 17-18. When obviousness is based on the teachings of multiple prior art references, the Examiner must also establish some "suggestion, teaching, or motivation" that would have lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. *See Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1359-60 (Fed. Cir. 1999); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1572 (Fed. Cir. 1996). The Applicant(s) may rebut a *prima facie* showing of obviousness with evidence refuting the Examiner's case or with other objective evidence of nonobviousness. *See WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1359 (Fed. Cir. 1999).

JP '624 does not anticipate or render claim 4 obvious for the reasons discussed above. However, there is no suggestion to combine JP '624 and EP '434. Significantly, EP '434 teaches that it is "see-through" as reflected even in the title itself. The purpose of being able to see through the form is to determine if there are problems with the concrete such as the presence of a gap. (page 3, lines 29-30). JP'624 teaches the importance of having different laminated layers as discussed above. Thus, the problems being solved by the two references are entirely different. Moreover, JP '624 expressly teaches away from using the type of form as recited in EP '434. It talks about issues

Application No. 10/735,392
Amendment dated November 30, 2006
Reply to Office Action of November 2, 2006

Docket No.: 66138-0005

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66138-0005 from which the undersigned is authorized to draw.

Dated: May 23, 2007

Respectfully submitted,

By /Michael B. Stewart/

Michael B. Stewart

Registration No.: 36,018

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 10291

Attorney for Applicant